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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,142	03/03/2004	George H. Forman	10007903-2	4833

7590 08/19/2005

HEWLETT-PACKARD COMPANY
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EXAMINER	
HUFFMAN, JULIAN D	

ART UNIT	PAPER NUMBER
2853	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/792,142	FORMAN, GEORGE H.	
	Examiner	Art Unit	
	Julian D. Huffman	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *2 and 3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 2 and 3 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 22 June 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by 1.2 GB Firmware Utility developed by Apple Computer, Inc.

Apple Computer, Inc. discloses:

With regards to claims 1 and 4, a computer consumable component (floppy disk) employed with an associated computerized apparatus, comprising:

the consumable component (floppy disk);

incorporated with the consumable component, a magnetically readable memory (magnetic disk); and

embedded in the memory, readable program code containing at least one downloadable upgrade version of program code associated with a device selected from a group including, the consumable component (since the code is stored on the disk, it is associated with the floppy disk), the associated computerized apparatus (the computer uses the code to update the firmware of the hard-drive), and interactional program code associated with both the consumable device and the associated computing apparatus (program code read from the floppy disk is used by the computer to guide the user to perform the upgrade).

With regards to claim 5, interactive subroutines for allowing selection of options for installation, operation or both, of said readable program code (see steps 4 and 5 on page 2, note that the computer is being booted from the floppy, as stated in the second paragraph under the heading "Overview", since the hard-drive cannot undergo normal operation during an upgrade).

With regards to claim 6, program code for determining if the readable program code is compatible with the associated computerized apparatus, and, if not, program code for aborting any downloading of the readable program code (page 2, step 4).

With regards to claim 7, program code for recognizing an incompatibility with a version of an operating system of the associated computerized apparatus (page 2, step 4).

With regards to claim 9, program code for automatically determining whether the upgrade version of program code is required;

if the upgrade version is required, then downloading the upgrade version from the memory to the associated computerized apparatus (page 2, update note).

4. Claims 1, 10, 11, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirst et al. (U.S. 5,930,553).

Hirst et al. discloses:

With regards to claim 1, a computer consumable component employed with an associated computerized apparatus, comprising:

the consumable component (fig. 1, element 18);

incorporated with the consumable component a memory (element 19, column 4, lines 44-49); and

embedded in the memory, readable program code containing at least one downloadable, upgrade version of program code (column 5, lines 19-24) associated with a device selected from a group including, the consumable component, the associated computerized apparatus, and interactional program code associated with both the consumable device and the associated computing apparatus (the upgrade version of program code is used to upgrade the computerized apparatus and is associated therewith).

With regards to claim 10, the consumable component is a print cartridge (column 4, lines 45-49, a toner cartridge is a print cartridge).

With regards to claim 11, a print cartridge (fig. 1, element 18) comprising:

a memory (element 19) storing readable program code having a downloadable upgrade version of program code for a computerized apparatus that is in communication with the print cartridge (column 5, liens 19-24).

With regards to claims 14 and 15, the upgrade version includes program code for downloading an upgrade to a host computer or a computer operating system (the program code is for upgrading software in an image forming device which is run by a computer operating system, column 5, lines 37-53).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst et al. in view of 1.2 GB Firmware Utility developed by Apple Computer, Inc.

Hirst et al. discloses everything claimed with the exception of determining whether an upgrade version of program code is required for the computerized apparatus and if so, upgrading the computerized apparatus.

Apple teaches program code for determining whether an upgrade version of program code is required and if so, upgrading (the version of the program is compared to the upgraded version to determine if an upgrade is necessary, see Update Note).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide programming code in Hirst et al. to determine whether an upgrade is required by providing version numbers and comparing the version numbers, as taught by Apple, for the purpose of preventing unnecessary upgrading, thereby providing a more efficient program.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over 1.2 GB Firmware Utility developed by Apple Computer, Inc. in view of Bealkowski et al. (U.S. 5,878,256).

Apple discloses everything claimed with the exception of program code for notifying a use when a partial upgrade occurs.

Bealkowski et al. discloses program code for, after upgrading, notifying a user if an error occurs, which is equivalent to a partial upgrade (column 14, lines 32-35 and 39-41, fig. 8, if a full upgrade had occurred, there would be no errors detected).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the program of Apple to notify the user when a partial upgrade or error has occurred as taught by Bealkowski et al. for the purpose of enabling the user to call for service (column 14, lines 39-41).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst et al. in view of Bealkowski et al.

Hirst et al. discloses everything claimed with the exception of program code for notifying a use when a partial upgrade occurs.

Bealkowski et al. discloses program code for, after upgrading, notifying a user if an error occurs, which is equivalent to a partial upgrade (column 14, lines 32-35 and 39-41, fig. 8, if a full upgrade had occurred, there would be no errors detected).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the upgrade program of Hirst et al. to notify the user when a partial upgrade or error has occurred as taught by Bealkowski et al. for the purpose of enabling the user to call for service (column 14, lines 39-41).

Response to Arguments

9. The amendment to claim 7 has overcome the double patenting rejection.

Applicant's argument that Apple does not disclose a consumable is noted. However, a floppy disk is a consumable since it is capable of being consumed with data. Additionally, floppy disks have a limited lifetime and thus are capable of being consumed.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 9:30a.m.-6:00p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Julian D. Huffman
10 August 2005

K. FEGGINS 8/08
PRIMARY EXAMINER